

REMARKS

Claims 1-15 are pending in this application. By this amendment, claim 14 is canceled without prejudice or disclaimer, and claims 1 and 2 are amended. Following entry of this amendment, claims 1-13 and 15 will be pending. No new matter is added. Support for the amendments is found throughout the specification and originally filed claims, including at, e.g., the specification at page 19, lines 25-30. Entry of this amendment is respectfully requested.

With respect to all new and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any objection and/or rejection made by the Office. Applicants expressly reserve the right to pursue prosecution of any subject matter not presently claimed in one or more future or pending continuation and/or divisional applications.

Pursuant to MPEP § 2001.06(b), the Examiner's attention is directed to the following co-owned, co-pending U.S. patent applications: USSNs 10/145,128 and 10/013,921.

Information Disclosure Statement

The Examiner's remarks regarding the IDSs filed 8/12/02 and 8/19/03 are acknowledged. Applicants will resubmit an IDS that includes the information requested by the Examiner, as a separate filing. Consideration of this submission is respectfully requested.

Objections

The disclosure is objected to on two grounds. Applicants respectfully traverse the objections, which will be considered in turn.

The Examiner objects to the specification on the ground that the presence of embodiments phrased in "claim" language is allegedly improper. Applicants respectfully traverse this objection. The Examiner has cited no authority for the proposition that including description of additional embodiments phrased as claims is improper in the specification, and a review of the MPEP found no authority for this proposition. Accordingly, Applicants submit that the objection is improper, and withdrawal of the objection is respectfully requested. Applicants note that the claims in the present application appear in a section entitled "Claims", and commence on a separate sheet after the detailed description of the invention, as required by MPEP § 608.01(m). Accordingly, Applicants believe that it is clear that the claims in the application are found at pages 112-113, and that the text found at pages 7-17 is merely descriptive of some embodiments of the invention. Withdrawal of this objection is respectfully requested.

The Examiner objects to the amendment changing the cross-reference to related cases, filed August 13, 2004¹, as new matter on the ground that the applications “were not incorporated by reference in this application as originally filed”. The Examiner concludes that “the incorporation of such applications . . . constitutes new matter.” Office Action, Page 2. Applicants respectfully traverse this rejection.

The applications listed in the cross-reference to related applications were properly incorporated by reference in the application as originally filed via a statement in the transmittal letter. Applicants direct the Examiner’s attention to the transmittal filed with the present application, which incorporates by reference the priority applications to the present application listed in the cross-reference to related applications added in the Amendment dated August 13, 2004 (USSN 60/081,071 filed April 7, 1998, PCT/US99/05028, filed March 8, 1999, and PCT/US00/04341, filed February 18, 2000). *See* patent application transmittal, paragraph spanning pages 1 and 2.

Priority applications may be incorporated by reference using a statement in the transmittal letter. Specifically, MPEP § 201.06(c)IV recites

[a]n applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are ‘hereby incorporated herein by reference.’ The statement may appear in the specification or in the application transmittal letter.

(emphasis added).

Accordingly, it is evident that the priority applications to the present application were properly incorporated by reference, and that the cross-reference to related applications added by the amendment dated August 13, 2004 does not constitute new matter. Withdrawal of the objection is respectfully requested.

Priority

The Examiner denies the priority claim for the present application. Applicants respectfully traverse the denial of the priority claim. The parent applications to the present application were properly incorporated by reference into the present application, as discussed above in the section entitled “Objections”. Accordingly, the present application does disclose the utilities taught in the parent applications, contrary to the Examiner’s statement in the Office

¹ The Office Action refers to an amendment filed “8/14/2001”. Applicants note that amendments to the specification adding cross-reference to related applications were filed on 8/23/2001, 6/30/04, and 8/13/04. Applicants will address the amendment filed 8/13/04, but note that the arguments apply equally to the amendments filed 8/23/01 and 6/30/04.

Action. In addition, Applicants do not necessarily agree with the Examiner's characterization of the utilities disclosed in the parent applications. For example, PCT/US00/04341 (page 336, line 33 to page 339, line 21) and PCT/US99/05028 (page 275, lines 1-23) disclose use of PRO866 as an anti-proliferative agent, and PCT/US00/04341 discloses use of PRO866 as an immune stimulant (page 361, line 19 to page 362, line 13).

Applicants respectfully request that the Examiner withdraw the denial of the priority claim.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Applicants respectfully traverse this rejection.

Claims 1 and 2 reciting "the extracellular domain" or "the extracellular domain . . . lacking its associated signal sequence" are rejected as allegedly indefinite. Applicants respectfully traverse this rejection. The claims have been amended and no longer recite the offending phrases. Withdrawal of this rejection is respectfully requested.

Claims 1 and 2 reciting "lacks its associated signal peptide" are rejected as allegedly indefinite on the ground that no signal peptide has been described. Applicants respectfully traverse this rejection.

The test for definiteness under 35 U.S.C. § 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Applicants respectfully submit that one of ordinary skill understands the meaning of the phrase "lacks its associated signal peptide", and thus that the rejected claims are clear. Applicants note that methods for determination of the presence or absence or size of signal peptides are well known in the art, and that some of these are further described in the specification. *See, e.g.*, specification at page 1, lines 6-16. Moreover, the specification does describe the signal peptide of TAT171. Specifically, Figure 10 discloses that the TAT171 signal peptide consists of amino acids 1-31 of Figure 10. Accordingly, Applicants submit that the rejected claims are clear, and withdrawal of this rejection is respectfully requested.

Claim 14 is rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the specification discloses that some embodiments of the antibodies of the invention are capable of inducing death of a cell to which it binds. Thus, claim 14 provides a further structural limitation and is not an inherent feature of all antibodies of

claims 1 and 2. However, to expedite prosecution, claim 14 has been canceled. Withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-6 and 11-13 are rejected under 35 U.S.C. § 112, first paragraph as allegedly lacking written description on the ground that 37 CFR 1.806 allegedly requires a statement in the specification that “the deposit will be maintained for a term of at least 30 years and at least five (5) years after the most recent request for the furnishing of a sample of the deposit was received by the depository”. (Office Action, page 13). Applicants respectfully traverse this rejection. The specification has been amended to insert the language requested by the Examiner. Withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102

1. Claims 1-9 and 12-15 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,682,902 (Harkins, et al.). Applicants respectfully traverse this rejection.

Harkins is not prior art to the present application. The examiner accords Harkins the 102(e) date of Dec. 16, 1999. By contrast, as explained in the section entitled “priority”, the present application claims the benefit of parent applications USSN 60/081,071 filed April 7, 1998, PCT/US99/05028, filed March 8, 1999, and PCT/US00/04341, filed February 18, 2000. Accordingly, Harkins is not a 102(e) reference to the present application, and withdrawal of this rejection is respectfully requested.

With respect to claim 2, Applicants further submit that Harkins et al do not disclose antibodies that bind to a polypeptide comprising: (a) the amino acid sequence shown in Figure 8 (SEQ ID NO:8); (b) the amino acid sequence shown in Figure 8 (SEQ ID NO:8), lacking its associated signal peptide; (c) an amino acid sequence encoded by the nucleotide sequence shown in Figure 3 (SEQ ID NO:3); (d) an amino acid sequence encoded by the full-length coding sequence of the nucleotide sequence shown in Figure 3 (SEQ ID NO:3); or (e) an amino acid sequence encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209750, as required by claim 2. Withdrawal of this rejection is respectfully requested.

2. Claims 1-8 and 12-15 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by WO99/46281 (Wood, et al.), published Sept. 16, 1999. Applicants respectfully traverse this rejection.

Wood et al. is not prior art to the present application. As noted above, the present application claims the benefit of parent applications USSN 60/081,071 filed April 7, 1998, PCT/US99/05028, filed March 8, 1999, and PCT/US00/04341, filed February 18, 2000. By

contrast, Wood et al. published on Sept. 16, 1999, and thus, is not a 102(b) reference to the present application. Withdrawal of this rejection is respectfully requested.

3. Claims 1-9 and 12-15 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by WO00/37638 (Ashkenazi, et al.), published June 29, 2000. Applicants respectfully traverse this rejection.

Ashkenazi, et al is not prior art to the present application. As noted above, the present application claims the benefit of parent applications USSN 60/081,071 filed April 7, 1998, PCT/US99/05028, filed March 8, 1999, and PCT/US00/04341, filed February 18, 2000. By contrast, Ashkenazi published on June 29, 2000, and thus, is not a 102(b) reference to the present application. Withdrawal of this rejection is respectfully requested.

4. Claims 1-9 and 12-15 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by WO098/45442 (Sheppard, et al.), published Oct. 15, 1998. Applicants respectfully traverse this rejection.

Sheppard is not prior art to the present application. As noted above, the present application claims the benefit of parent applications USSN 60/081,071 filed April 7, 1998, PCT/US99/05028, filed March 8, 1999, and PCT/US00/04341, filed February 18, 2000. By contrast, Sheppard published on Oct. 15, 1998, and thus, is not a 102(b) reference to the present application. Withdrawal of this rejection is respectfully requested.

5. Claims 1-8 and 12-15 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,871,969 (Hastings, et al.). Applicants respectfully traverse this rejection. Claim 1 has been amended and now recites "a polypeptide having at least 99% amino acid sequence identity to: (a) the amino acid sequence shown in Figure 8 (SEQ ID NO:8) . . .". By contrast, Hasting discloses a polypeptide that is 98.9% identical to the amino acid sequence of SEQ ID NO:8. Withdrawal of this rejection is respectfully requested.

With respect to claim 2, Applicants further submit that Hastings et al do not disclose antibodies that bind to a polypeptide comprising: (a) the amino acid sequence shown in Figure 8 (SEQ ID NO:8); (b) the amino acid sequence shown in Figure 8 (SEQ ID NO:8), lacking its associated signal peptide; (c) an amino acid sequence encoded by the nucleotide sequence shown in Figure 3 (SEQ ID NO:3); (d) an amino acid sequence encoded by the full-length coding sequence of the nucleotide sequence shown in Figure 3 (SEQ ID NO:3); or (e) an amino acid sequence encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209750, as required by claim 2. Withdrawal of this rejection is respectfully requested.

6. Claims 1-8 and 12-15 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,287,777 (Sytkowski, et al.). Applicants respectfully traverse this rejection.

Sytkowski et al. is not prior art to the present application. The examiner accords Sytkowski the 102(e) date of Aug. 10, 1999. By contrast, the present application claims the benefit of parent applications USSN 60/081,071 filed April 7, 1998, PCT/US99/05028, filed March 8, 1999, and PCT/US00/04341, filed February 18, 2000. Accordingly, Sytkowski is not a 102(e) reference to the present application, and withdrawal of this rejection is respectfully requested. Applicants further note that claim 1 has been amended and now recites “a polypeptide having at least 99% amino acid sequence identity to: (a) the amino acid sequence shown in Figure 8 (SEQ ID NO:8) . . .”.

With respect to claim 2, Applicants further submit that Sytkowski et al do not disclose antibodies that bind to a polypeptide comprising: (a) the amino acid sequence shown in Figure 8 (SEQ ID NO:8); (b) the amino acid sequence shown in Figure 8 (SEQ ID NO:8), lacking its associated signal peptide; (c) an amino acid sequence encoded by the nucleotide sequence shown in Figure 3 (SEQ ID NO:3); (d) an amino acid sequence encoded by the full-length coding sequence of the nucleotide sequence shown in Figure 3 (SEQ ID NO:3); or (e) an amino acid sequence encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209750, as required by claim 2. Withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. 103(a)

Claims 10 and 11 are rejected under 35 U.S.C. § 103 as allegedly obvious over Harkins or Ashkenazi or Sheppard, any one in view of USP 5,208,020 (Chari et al). Applicants respectfully traverse this rejection. As noted above, none of Harkins or Ashkenazi or Sheppard is prior art to the present application. Thus, none of these references may be considered in this 103 rejection. Chari is cited merely for maytansinoid or calicheamicin toxins. However, Chari does not disclose the claimed antibodies. Accordingly, Applicants submit that a prima facie case of obviousness has not been made. Withdrawal of this rejection is respectfully requested.

SUMMARY

Applicants believe that this application is now in condition for allowance and respectfully requests that the outstanding rejections be withdrawn and this case passed to issue. No new matter has been introduced, and entry of these amendments is respectfully requested. The Examiner is invited to contact the undersigned at (650) 467-6222 in order to expedite the resolution of any remaining issues.

In the unlikely event that this document is separated from the transmittal letter or if fees are required, Applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Respectfully submitted,
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